

Appl. No.: 09/856,835
Group Art Unit: 1623
Applicants' Reply to Paper No. 11

REMARKS

Claims 24-35 are currently pending in the present application.

Claim 24 has been amended herein to specifically point out that in formula (I), when R^1 is hydrogen, Z is glucose and n equals 1, the glucose unit is substituted by R^2 at its primary hydroxy group and R^2 is not 4-phenylbutyryl or a hydrophobic aromatic carboxylic acid moiety. The amendment to claim 24 is supported by the Specification, in the Examples. Each of the Examples set forth in the instant Specification discloses a novel salicyl alcohol derivative of the formula (I), as claimed, wherein R^1 is hydrogen, Z is glucose and n equals 1, and the glucose unit is substituted at the primary hydroxy group, *i.e.*, C-6. No new matter has been introduced. Applicants submit that the amendment to claim 24 made herein places the application in a condition for allowance, as discussed in detail below. Accordingly, entry of the amendment after final rejection is believed to be proper. A complete listing of all claims ever presented is included herein in accordance with 37 C.F.R. §1.121(c). Entry of the amendment to claim 24 is therefore proper and respectfully requested.

In Paper No. 11, the Examiner rejects claims 24-30, 33 and 35 under 35 U.S.C. §102(b), as being anticipated by Picard, *et al.*, "Hemisynthesis of the Naturally Occurring Tremuloidin", PHYTOCHEMISTRY, Vol. 31(8), pp. 2909-10 (1992), also referred to as "Pearl, *et al.*" by the Examiner, (hereinafter referred to as "the Phytochemistry article"). Specifically, the Examiner contends that the Phytochemistry article discloses a salicyl alcohol derivative according to formula (I), as set forth in claim 24, wherein R^2 is benzoyl, R^1 is hydrogen and Z is glucose. The Examiner contends that the compound is β -D-glucopyranoside-2-(hydroxymethyl)phenyl-2-benzoate. On this basis, the Examiner argues that the claims are anticipated.

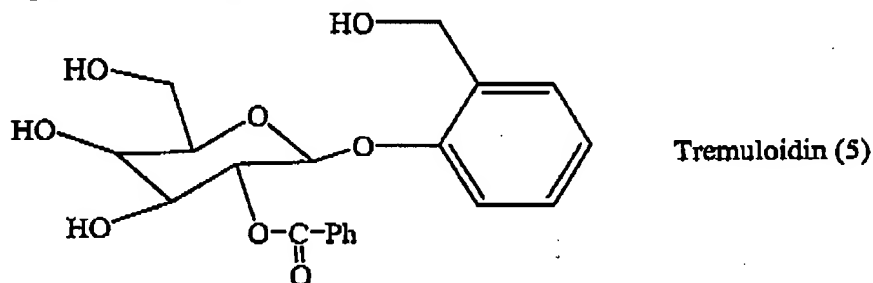
Applicants strenuously, but respectfully, traverse the Examiner's rejection and the arguments and contentions in support thereof for the following reasons. In order for a rejection under 35 U.S.C. §102(b) to be proper, each and every element of the claimed invention must be taught, either expressly or inherently, in a single prior art reference. (*See, e.g.*, M.P.E.P. §2131).

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Applicants submit that the Phytochemistry article fails to teach each and every element of the claimed invention, as amended herein.

Applicants' claimed invention, as set forth in claim 24 as amended herein, is directed to novel salicyl alcohol derivatives of formula (I), $R^1-OCH_2-Ph-O-Z-(R^2)_n$, wherein each of the variable substituents is defined as set forth in the claim. As amended herein, when R^1 is hydrogen, Z is glucose and n equals 1, the glucose unit is substituted by R^2 at its primary hydroxy group and R^2 is not 4-phenylbutyryl or a hydrophobic aromatic carboxylic acid moiety.

The Phytochemistry article discloses the compound tremuloidin. The Examiner has identified the compound as β -D-glucopyranoside, 2-(hydroxymethyl)phenyl, 2-benzoate, based on the Chemical Abstract Index Name assigned in the abstract reference to the Phytochemistry article. (See, Paper No. 11, p. 2). The Phytochemistry article more precisely identifies the compound, tremuloidin, as 2'-O-Benzoyl-7-hydroxy-o-tolyl- β -D-glucopyranoside. (See, the Phytochemistry article, p. 2909, col. 2, lines 26-27). However, regardless of the nomenclature used to identify the compound tremuloidin, having the following molecular structure, as depicted in the Phytochemistry article:



the reference still fails to disclose compounds in accordance with amended claim 24 wherein the glucose unit is substituted with R^2 at its primary hydroxy group when R^1 is hydrogen, Z is glucose and n equals 1. Tremuloidin bears a substituent at the C-2 hydroxyl group, not the primary C-6 hydroxyl.

Applicants respectfully submit that the claimed novel salicyl alcohol derivatives do not read on tremuloidin. Accordingly, the Phytochemistry article fails to anticipate the claimed invention. Applicants respectfully request reconsideration and withdrawal of the Examiners rejection under 35 U.S.C. §102(b).

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In view of the amendment made herein and the comments set forth above, Applicants submit that all pending claims patentably distinguish over the prior art of record and known to Applicants, either alone or in combination. Accordingly, reconsideration, withdrawal of the rejections and a Notice of Allowance for all pending claims are respectfully requested.

Respectfully submitted,

RALF OTTO, et al.

December 16, 2003
(Date):

By: 

AARON R. ETTELMAN

Registration No. 42,516

COGNIS CORPORATION

300 Brookside Avenue

Ambler, PA 19002

Telephone: (215): 628-1413

Facsimile: (215): 628-1345

E-Mail: AARON.ETTELMAN@COGNIS-US.COM

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